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10/029,006	12/28/2001	Hitoshi Shindo	461-43	3756

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8
EXAMINER

VIJAYAKUMAR, KALLAMBELLA M

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-8

Office Action Summary

Application No.

10/029,006

Applicant(s)

SHINDO ET AL.

Examiner

Kallambella Vijayakumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Election dated 06/09/03 in Paper-6.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 6-13 and 19-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10029006, filed on 12/28/2001. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Claims 1-26 are currently pending with the application.

Applicant's election without traverse of Group-I, Claims 1-5 and 14-18 in Paper No. 6 is acknowledged. Claims 6-13 and 19-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups, there being no allowable generic or linking claim. This action is made FINAL.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A (1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner on form PTO-892 has cited the references and/or the applicant has provided IDS on PTO-1449, they have not been considered.

Claim Rejections - 35 USC § 102
Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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The use of phrase "for constituting electrode layers.....and baking the laminate" in the claims-1 and 14 have not been treated with patentability. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The examiner construes this language as "Intended Use" and not treated with merits for patentability.

Claims 1-5 are rejected under 35 U.S.C. 102(b) or in the alternative under 35 U.S.C. 103(a) as being unpatentable over Nakatani et al (JP 03-048415).

Nakatani et al teach an inner electrode paste composition comprising 80.0-99.0wt.% of CuO powder, 0.5-10wt.% of at least one or more types selected from MgO, Nb₂O₅, Ta₂O₅, NiO, TiO₂, WO₃, CaO, ZnO and 0.5-10.0wt.% of PbO dispersed in an organic vehicle containing at least an organic binder and a solvent, and making a laminated ceramic capacitor containing lead composite perovskite compound as a dielectric using this paste (Abstract). PbO and lead composite perovskite compound meet the limitation of a co-operative compound. All the limitations of the instant claims are met.

The reference is anticipatory.

In the alternative that the disclosure by Nakatani et al be insufficient to arrive at the limitations of the instant claims by the applicants, it would have been obvious for a person of

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ordinary skill to make necessary changes to the composition of Nakatani by the choice of design in arriving at the instant claim limitations by the applicants with reasonable expectation of success.

Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hakotani et al (JP 06-223621) in view of Nakatani et al (JP 03-04815) or Hamada et al (JP 03-208831).

Hakotani et al disclose a conductor paste composed of 30.0-70.0wt.% conductor material containing primarily CuO powder, copper powder in the amount of 10.0-60.0wt.% of the conductor material, and 30.0-70.0wt.% crystallized glass ceramic powder dispersed in an organic vehicle composed of at least organic binder and solvent (Abstract).

Hakotani differs from the applicants in not disclosing the explicit use of lead containing compounds in the paste composition.

Nakatani et al disclose the use of PbO in electrode paste formulation containing primarily of CuO (Abstract). Hamada et al (JP 03-208831) disclose the use of PbO-B₂O₃ or PbO-SiO₂-B₂O₃ glass frit in a conductive paste composition containing Cu powder and CuO (Abstract).

Hakotani teaches the composition of conductor paste comprising of Cu and CuO. It would have been obvious for a person of ordinary skill to add lead compounds such as PbO or the PbO-containing glass frit in the electrode paste composition of Hakotani to benefit from such an incorporation as taught by either Nakatani or Hamada in the analogous art of electrode/conductive paste, and with reasonable expectation of success in arriving at the limitations of the instant claims by the applicants.

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Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kondo et al (JP 63-295491) discloses a metallizing composition, and Ogawa et al (JP 05-174612) disclose an electrode paste that is similar in composition to that of the applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 703-305-4931. The examiner can normally be reached on M-Th, 07:00 - 15.30 hrs, Fri: 05.30-14.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

kmv
August 11, 2003


YOGENDRA N. GUPTA
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